



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,460	06/01/2000	Jonathan Strietzel	252/173	3051

7590 01/10/2003

NOEL C GILLESPIE
BROBECK PHLEGER & HARRISON
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

EXAMINER

NGUYEN, QUYNH H

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,460

Applicant(s)

STRIETZEL, JONATHAN

Examiner

Quynh H Nguyen

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21- 23, and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Gregorek et al. (U.S. Patent 5,557,658).

Regarding claim 21, Gregorek teaches the steps of: storing a plurality of advertisements (col. 9, lines 48-52); selectively associating one or more of the plurality of advertisements with a communication (col. 9, lines 5-8); playing or otherwise displaying the one or more advertisements to a user associated with the communication (col. 10, lines 58-65); connecting the communication with a destination and completing a transaction of the communication after the one or more advertisements has been played or otherwise displayed for the user (col. 11, lines 46-48).

Regarding claims 22 and 23, in the reference col. 19, lines 49-61, the message generator transmits either standard or menu, an announcement based upon the geographic location or time of day reads on claimed “user information including at least one of: user’s primary language, preferences, communications provider, communications plan, communication means, and geographic location” and selectively associating the message based on the user information.

Art Unit: 2642

Regarding claim 26, in the reference col. 14 lines 50-54, reads on claimed invention "user's preferences include at least one of: information related to the types of services, types of products the user is interested in or typically uses..."

Regarding claim 27, Gregorek teaches billing user at different rate based on the inclusion of the advertisements in the communication (col. 13, lines 2-14).

Regarding claim 28, Gregorek teaches the user staying online after the communication transaction has ended and selecting to receive more information related to one or more advertisements played during the communication (col. 14, lines 11-49).

Regarding claim 29, Gregorek teaches the user selecting to be directly connected with a company associated with one of the advertisements played during the communication (col. 14, lines 8-11).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1- 12, 14-20, 24, 25, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent 5,557,658).

Regarding claim 1, Gregorek teaches a telecommunication advertising means comprising an advertisement database (Fig. 2, 100 and 102) that stores subscriber specific or third party advertisements and a processing means (Fig. 1, 10) configured to selectively associate at least

Art Unit: 2642

one advertisement in the advertisement database with a source of an incoming communication (col. 9, lines 5-15 and col. 11, lines 32-36).

Gregorek does not suggest associate at least one advertisement with a destination of the incoming communication.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that selecting and advertisement associate with a destination of the incoming communication is inherent from the telecommunication advertising for selecting at least one advertisement in the advertisement database with a source of an incoming communication.

Regarding claims 2, 3 and 16, Gregorek teaches a router ("message generator") to route any messages associated with the source to the source, and any message associated with the destination to the destination (col. 8, lines 8-17) and the router is in Fig. 1, system 10.

Regarding claim 4, Gregorek teaches the telecommunications advertising means is part of a fixed telecommunications (Fig. 1, 15).

Regarding claim 5, Gregorek teaches the processing means is configured to selectively associate a particular advertisement or advertisements with the incoming communication based upon **at least one of** a number of criteria or factors such as the time of day (col. 9, lines 5-12).

Regarding claims 6 and 8, Gregorek teaches the source or destination of the incoming communication is for used with any type of communications network (col. 6, lines 22-32).

Claim 7 is rejected for the same reasons as discussed above with respect to claim 5. Furthermore, the processing means is configured to selectively associate a particular advertisement or advertisements with the destination is inherent in the telecommunication advertising system.

Art Unit: 2642

Regarding claims 9 and 17, Gregorek teaches the incoming communication is any one of the group comprised of: a data; video; a voice/audio; a paging; an email; and a combination of any of a textual data, a video data, a voice/audio, a paging, and an email communication (col. 6, lines 22-26).

Regarding claims 10, 11, 18, and 19, Gregorek does not suggest the processing means in configured to selectively associate a same of different advertisement or advertisements with the source and the destination. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the communication system 10 is able to select the type of announcements to be played based upon a number of criteria and factors, the system would be easily select the same or different advertisements with the source and the destination.

Regarding claims 12 and 20, Gregorek teaches the messages associated with the source and the advertisements associate with the destination are each one of: a subscriber specific message; a jingle; a text advertisement; an audio advertisement; a video advertisement; and a graphic advertisement (col. 10, lines 58-65).

Claim 14 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Gregorek teaches a telecommunications system comprising a network subsystem including: a switch (Fig. 1, 18 and 22), one or more administrative means configured to store required administrative information for each of a plurality of terminals connected/registered in the telecommunications system (Fig. 2, 17).

Claim 15 is rejected for the same reasons as discussed above with respect to claim 2. Furthermore, Gregorek teaches the switching center is configured to route communications

Art Unit: 2642

between the terminals (Fig. 1, 12 and 12a); route communications from the terminals to fixed network users via fixed network interface (col. 10, lines 43-65).

Claims 24 and 25 are rejected for the same reasons as discussed above with respect to claims 1 and 21.

Regarding claims 30 and 31, Gregorek does not teach method of updating user preferences via a telephone or Internet comprising: a user accesses a record containing the user's preferences; user changing or updating user's preferences; storing and using the updated version of the record. It would have been obvious to one of ordinary skill in the art at the time the invention was made that in the reference, the message generator is capable of dialing or being dialed by remote computing equipment in order to update previously stored announcements, therefore user would be able to access and update user's preferences.

Claim 32 is rejected for the same reasons as discussed above with respect to claim 26.

5. Claim 13 is allowed.

Reasons For Allowance

6. Regarding claim 13, the prior art fails to teach a combination of the steps of:

an advertisement database that stores subscriber specific or third party advertisements;
and

a processing means configured to selectively associate, based on one or more factors selected from the group consisting of user preferences, language, communication source, communication type, time of day, communication destination, and geography at least one advertisement in the advertisement database with an incoming communication in at least one of the following ways:

Art Unit: 2642

associate at least one advertisement with a distribution of said incoming communication;

associate at least one advertisement with a source of said incoming communication;

associate at least one advertisement with said source and at least one advertisement with said distribution, in the specific combination as recited in claim 13.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gerszberg et al. (U.S. Patent 6,377,664) teaches video phone multimedia announcement answering machine. Marino et al. (U.S. Patent 4,850,007) teaches telephone toll service with advertising.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry, please label the response "EXPEDITED PROCEDURE")

or: (703) 308-6296, (for informal or draft communication, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Art Unit: 2642

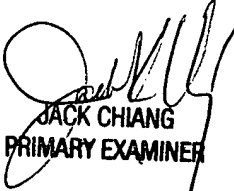
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 703-305-5451. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

qhn

Quynh H. Nguyen
January 06, 2003


JACK CHIANG
PRIMARY EXAMINER